



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,875	04/19/1999	HUBERT MANHES	02581P0045A	8095

7590 05/16/2003

WESLEY W WHITMYER JR
ST ONGE STEWARD JOHNSTON & REENS
986 BEDFORD STREET
STAMFORD, CT 069055619

[REDACTED] EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 05/16/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/214,875	MANHES, HUBERT
	Examiner	Art Unit
	Vy Q. Bui	3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 24-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 24-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

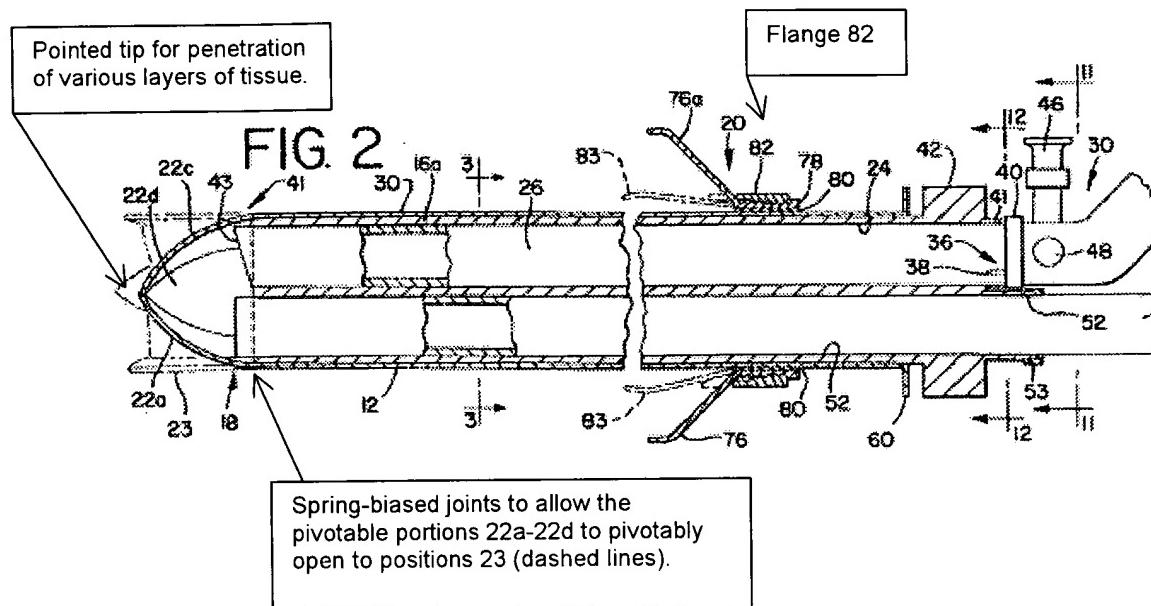
-25

2. Claims 24 and 28-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KO (5,354,302).

As to claims 24-25 and 28-29, KO (Fig. 2, 7-10) discloses a trocar sleeve 10 comprising an elongate part 12. The trocar sleeve 10 comprises pivotable parts/wings/wedges 22a-22d (Fig. 1, 2 and 9; line 63, column 7 to line 6, column 8) each having a blade end portion and spring-biased joints (see Fig. 2 shown below). The pivotable parts converge toward one another to form a **conical penetration tip** 18 in a piercing position (Fig. 1, 2 and 6) for pushing into and through various layers of body tissue (lines 42-45, column 8). Notice that KO refers conical penetration tip 18 as blunt tip because of the overall rounded conical shape of the penetration tip 18, however, from Fig. 2 and 9, the pivotable parts/wings/wedges 22a-22d made of metal/plastic (column 9, lines 64-68) do form a pointed tip which permit cutting/penetrating/piercing at least at some degree of a body wall/tissue by itself.

Art Unit: 3731

As to claims 30-31, KO (Fig. 6-8) discloses flange 82 bearing against an outer side of a body wall and displaceable along the distal section of the elongate part 12.



Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
 2. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over KO (5,354,302) I view of SORENSEN et al (5,320,627).

As to claims 26-27, KO discloses substantially all structural limitations as recited in the claims including the pivotable parts/wings/wedges 22a-22d bearing against an

inner side of the body wall (Fig. 8-9), except for the spring-biased joints biasing the pivotable parts/wings/wedges 22a-22d away from one another to an operative position upon displacement of an instrument along the passage. However, SORENSEN (Fig. 17-19; lines 12-53, column 13) discloses springs 108a-108d biasing pivotable parts 106a-106d away from one another to an operative position upon displacement of an elongate cutting tool 142 (Fig. 16) along a passage/lumen of trocar 103. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide KO device with a spring-biased joints as taught by SORENSEN, as this configuration would provide spring-biased joints to bias the pivotable parts 22a-22d away from one another in an operative position.

Response to Arguments

Applicant's arguments filed 3/4/2003 have been fully considered but they are not persuasive.

Basically, the applicant asserts that the KO tip 18 does not permit cutting of a body wall without an additional trocar mandrel. However, according to the disclosure of the KO reference as shown in Fig. 9, for example and column 8, lines 42-45, which discloses that "the operator then pushes dissectoscope 10 into and through the **various tissue layers** which may be readily accomplished **due to the conical shape of the penetration end 18**", which penetration end 18 is made of metal (column 9, lines 64-66), it would be reasonable to one of ordinary skill in the art to recognize that the penetration end 18 can use to cut a body wall by itself. In addition, even there is different intended use of the KO device and the device in the present application, it

would be reasonable to conclude that the present invention as claimed has not been structurally defined over KO reference.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

VQB
May 12, 2003


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700